

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 32  
RLS/cv

10/4/00

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Bruce D. Watts

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Serial No. 75/529,793

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Request for Reconsideration

Bruce D. Watts, pro se.

Robert Clark, Trademark Examining Attorney, Henry S. Zak,  
Senior Trademark Attorney, Law Office 108 (David Shallant,  
Managing Attorney)

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Before Simms, Wendel and Holtzman, Administrative Trademark  
Judges.

Opinion by Simms, Administrative Trademark Judge:

Applicant has requested reconsideration of our  
decision, issued August 7, 2000, affirming the refusal to  
register the asserted mark BIRTHDAY BALLOONS for mail order  
gift balloon services. We held that the evidence of record  
was sufficient to establish that these words identified to  
the general public the category or class of applicant's  
mail order services--that those services involve the

delivery of balloons for birthdays or birthday balloons. We stated that the asserted mark was incapable of identifying and distinguishing applicant's services from those of others who are engaged in the delivery of birthday balloons.

Applicant argues that the Examining Attorney only produced six articles showing use of the words "birthday balloons," and applicant's own research using the Lexis Nexis research service revealed only 32 (or 37) articles from major U.S. newspapers in 1999 which used these words in a generic manner.<sup>1</sup>

First, we should make clear that our decision was based upon the record supplied by applicant and the Examining Attorney. That record includes, among other things, a number of excerpts showing use of the words "birthday balloons." Aside from the two references set forth in the Board's opinion, the remaining references from domestic news sources are set forth below:

Faculty and staff sported special  
birthday balloon pins, and class parents  
provided the cupcakes.  
Capital, January 29, 1999

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<sup>1</sup> The list of references attached to applicant's request for reconsideration shows that some of these publications are not U.S. publications.

... an insurance company makes a life-or-death decision," said Ellison, birthday balloons floating above his wheelchair. Seattle Post-Intelligencer, February 24, 1999

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As the University of Washington men's basketball team staggers toward March with all the bounce of a 3-day-old birthday balloon, Husky fans ought to take a moment and rejoice. The News Tribune, February 28, 1999

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Back outside, we felt well-fed and entertained. And we had two white birthday balloons as a bonus. The Post and Courier, March 4, 1999

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"The only thing we found out in the woods were some birthday balloons," said Greene, a private eye who is an expert in finding missing people. The Times Union, August 8, 1999

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Well, enough self-promotion. I've got just enough hot air left to blow up a couple of birthday balloons. Pass the pink one. Austin American-Statesman, August 26, 1999

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The Frontgate Image Projector has patterns you can shine on the house including a Christmas tree, American flag, Jack-O Lantern and birthday balloon...

The Des Moines Register, September 13,  
1999

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"Her birthday balloon still has helium in it," said her mother, Tammy Tilly. "It's in her bedroom."  
South Bend Tribune, September 25, 1999

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...This device beams a crisp special-occasion image onto garage doors or other flat surfaces on the exterior of a home. The projector includes 20 images, such as a Christmas tree, American flag and birthday balloon...  
The Baltimore Sun, October 3, 1999

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I also asked for a little birthday cake. Instead, we had a fun waiter who brought two birthday balloons on long ribbons anchored with Mickey Mouse cookies, a handful of shiny confetti sequins in the shape of Mickey that showered us all, and a huge chocolate cake with candles.  
The Idaho Statesman, October 6, 1999

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... It comes with 20 foil image patterns, including Christmas tree, American flag and birthday balloon. Optional color slides include jack o'lantern, birthday, New Year's and millennium motifs.  
St. Petersburg Times, October 9, 1999

While the Board noted, parenthetically, that there were other stories in which these words appeared, we can

and must decide this case only on the basis of the material actually made of record.

Applicant appears to be under the misconception that, in order for an asserted mark to be held generic, a great number of articles showing generic use must be of record. However, as in other situations (such as surname cases), there is no magic number of uses which must be of record before a term may be determined to be generic. The critical question is the relevant public's perception or understanding of the term sought to be registered. *Loglan Institute, Inc. v. Logical Language Group, Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992) and cases cited therein. Evidence of the public's understanding of a term may be obtained from various competent sources including dictionaries, newspapers and magazines, as well as other sources. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985). Indeed, a quick review of some of the reported cases shows that some terms have been held generic on the basis of relatively few instances of generic uses. See, for example, *A.J. Canfield v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3<sup>rd</sup> Cir. 1986) ("Chocolate Fudge" held generic for diet soda, court noting that the fact that plaintiff was the only producer of diet chocolate fudge soda did not mean that the name is not

generic); *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 231 USPQ 579 (7<sup>th</sup> Cir. 1986) (*LIQUID CONTROLS* held generic for meters for measuring the flow of liquids, where the evidence presented by the defendant consisted largely of dictionary definitions, court stating that "we do not believe that the principle that the validity of a mark is to be determined by looking at the mark as a whole precludes a court from examining the meanings of the component words in determining the meaning of the mark as a whole"); *In re Northland Aluminum Products, Inc.*, *supra* (*BUNDT* held generic for ring cake mix on evidence consisting of recipes from four cookbooks and four newspaper articles); *National Conference of Bar Examiners v. Multistate Legal Studies*, 692 F.2d 478, 216 USPQ 279 (7<sup>th</sup> Cir. 1982) (*MULTISTATE BAR EXAMINATION* held unprotectible without any apparent evidence of generic use by others or the press, the court stating, "Under settled trademark law if the components of a trade name are common descriptive terms, a combination of such terms retains that quality... The name has a common descriptive quality; it indicates the type of service merchandised and not any particular merchandiser."); *Reese Publishing Co. v. Hampton International Communications, Inc.*, 620 F.2d 7, 205 USPQ 585 (2d Cir. 1980) (*VIDEO BUYER'S GUIDE* held generic

despite lack of evidence of this precise phrase by third parties, although there was evidence that BUYERS GUIDE was a generic phrase describing a class of publications frequently coupled with the name of a particular type of electronics product); CES Publishing Corp. v. St. Regis Publications, 531 F.2d 11, 188 USPQ 612 (2d Cir. 1975) (CONSUMER ELECTRONICS MONTHLY held generic where other publications used CONSUMER ELECTRONICS in their names, court stating that "... it is hard to think of the name for a magazine, directed deliberately and effectively to industry personnel, which more accurately names the class of trade magazines within that industry than one which simply gives itself the name of the trade plus the word 'Monthly.'"); Clairol, Inc. v. Roux Distributing Co., 280 F.2d 863, 126 USPQ 397 (CCPA 1960) (HAIR COLOR BATH for hair tinting preparation held generic where no apparent evidence of third-party use); Continental Airlines Inc. v. United Air Lines Inc., 53 USPQ2d 1385 (TTAB 1999)(E-TICKET for computer reservation and ticketing services held generic on summary judgment on the basis of dictionary definitions and over 110 excerpts from printed publications, use by competitors and the U.S. government); In re Dial A Mattress Operating Corp., 52 USPQ2d 1910 (TTAB 1999)(1-888-M-A-T-R-E-S-S held generic for mattress telephone shop-at-home

retail services without any apparent evidence of third-party use or excerpts from printed publications); In re Log Cabin Homes Ltd., 52 USPQ2d 1206 (TTAB 1999)(LOG CABIN HOMES for building design and retail services held generic on the basis of "a few hundred" excerpts); In re Web Communications, 49 USPQ2d 1478 (TTAB 1998)(WEB COMMUNICATIONS held generic for Internet consulting services on the basis of dictionary definitions and "several excerpts" from the Nexis database of printed publications); In re Sambado & Son Inc., 45 USPQ2d 1312 (TTAB 1997)(FRUTTA FRESCA held generic for fresh fruit on the basis of dictionary definitions and 40 excerpts from newspapers and magazines); In re Recorded Books Inc., 42 USPQ2d 1275 (TTAB 1997)( RECORDED BOOKS held generic for audio cassettes of literary works on the basis of over 70 excerpts and use in third-party registrations); and In re Medical Disposables Co., 25 USPQ2d 1801 (TTAB 1992)(MEDICAL DISPOSABLES held generic for disposable garments and other goods with evidence consisting of 11 excerpts).

Here, we believe that the evidence of record, including dictionary definitions of these ordinary words and the excerpts from newspaper articles, demonstrates that the primary significance of applicant's asserted mark to the average purchaser is the name of the product at the



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heart of applicant's mail order services. It is our belief that potential purchasers will likely perceive applicant's asserted mark as the generic name of the goods applicant delivers, and not as an indication of source or origin of applicant's services (or goods).

Applicant's request for reconsideration is denied.

R. L. Simms

H. R. Wendel

T. E. Holtzman  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board